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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,695	06/12/2001	Stephan Heck	H 3172A-PCT/US	6462

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EXAMINER

PRICE, ELVIS O

ART UNIT PAPER NUMBER

1621

DATE MAILED: 01/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,695

Applicant(s)

HECK ET AL.

Examiner

Elvis O. Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/554,631.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 3 and 4 are pending in the application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.09/554631, filed on 7/26/00.

Claim Rejections - 35 USC § 102(e)/103(a)

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Koehler et al. {U.S. Pat. 5,672,781}.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the

reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Applicants claim a **process** and the **product** of the said process for the preparation of a mixture of fatty alcohols having an iodine number in the range from 65 to 85 of the formula (I) R^1OH (I)

Wherein R^1 is a saturated or unsaturated, linear or branched radical having from 14 to 20 carbon atoms, wherein the process comprises the steps of:

- (a) fractionating palm oil fatty acid methyl esters to produce a first methyl ester fraction comprised substantially of C_{16} esters and a bottom product which is a second methyl ester fraction comprised substantially of unsaturated $C_{16/18}$ esters, and
- (b) hydrogenating the bottom fraction to give the corresponding alcohols under conditions such that the carbon-carbon double bonds remain intact.

Koehler et al. teach a process for preparing a mixture of fatty alcohols having an iodine number in the range from 20 to 110, more preferably 20 to less than 95, and having from 8 to 22 carbon atom aliphatic chain, wherein the aliphatic chain may be saturated or unsaturated, linear or branched. Koehler et al. teach that it is possible to obtain from palm oil a fatty methyl ester with chain lengths of 16 to 18 carbon atoms as the principle constituents and that the iodine value of the fatty alcohols (**product**) to be produced by the cited process is adjusted by fractionating the methyl esters before hydrogenation (Col. 3 lines 32-53). Fatty alcohols of the formula (I)



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Wherein R¹ is a saturated or unsaturated, linear or branched aliphatic radical having from about 8 to about 22 carbon atoms with iodine values from about 20 to about 110 are herein reported in the reference of Koehler et al. (see Col. 1 and 2). The difference between the applicants' claimed invention and the reference is that the range of the carbon chain length and the iodine value range of the reference's fatty alcohol products is greater than that of the applicants' fatty alcohol products.

It would have been *prima facie* obvious to one of ordinary skill in the art to prepare fatty alcohols as presently claimed because Koehler et al. teach a process of preparing fatty alcohols of the formula (I),



Wherein R¹ is a saturated or unsaturated, linear or branched aliphatic radical having from about 8 to about 22 carbon atoms with iodine values from about 20 to about 110, wherein the process comprises fractionating the fatty methyl esters, to arrive at the desired iodine value(s), before hydrogenation of the fatty methyl esters.

One of ordinary skill in the art would have been motivated to prepare fatty alcohols as presently claimed, which may be used as intermediates to prepare surfactants and skin care products, having an iodine number between 65 and 85 because Koehler et al. teach that fatty alcohols having iodine values from about 20 to 95, have favorable solidification point for use in cosmetic products (see Col. 1, lines 43-55 and Col. 2, lines 2-14).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,672,781. Although the conflicting claims are not identical, they are not patentably distinct from each other because Koehler et al. teach that it is possible to obtain from palm oil a fatty methyl ester with chain lengths of 16 to 18 carbon atoms as the principle constituents and that the iodine value of the fatty alcohols (**product**) to be produced by the process is adjusted by fractionating the methyl esters before hydrogenation (Col. 3 lines 32-53). Fatty alcohols of the formula (I)



Wherein R^1 is a saturated or unsaturated, linear or branched aliphatic radical having from about 8 to about 22 carbon atoms with iodine values from about 20 to about 110 are herein reported in the reference of Koehler et al. (see Col. 1 and 2). The difference between the applicants' claimed invention and the reference is that the range of the carbon chain length and the iodine value range of the Koehler et al. reference's fatty alcohol products is greater than that of the applicants' fatty alcohol products.

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This is a provisional obviousness-type double patenting rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 703 605-1204. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703 308-4532. The fax phone numbers for the organization where this application or proceeding is assigned is 703 308-4556 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

EOP

January 10, 2002


SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1200